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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,631	12/05/2003	Doug C. Eveland	16491-009002	9078
20985	7590	10/04/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			MULLEN, THOMAS J	
			ART UNIT	PAPER NUMBER
			2632	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,631	Applicant(s) EVELAND ET AL.	
	Examiner Thomas J. Mullen, Jr.	Art Unit 2632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/04, etc.</u> | 6) <input type="checkbox"/> Other: ____. |

1. The disclosure is objected to because of the following informalities: paragraph 0001, line 2, "to be issued" should be --which issued--, or something similar; and paragraph 0026, last 2 lines, it appears that "10 numerical digits" should be --9 numerical digits-- (i.e., the standard SSN is of the form 123-45-6789).

Appropriate correction is required.

2. Although the present application was filed under 35 U.S.C. 120 as a "continuation" application, there are substantial differences between the original disclosure (of application 09/841,154) and the disclosure set forth in the present specification and claims. Virtually all of the paragraphs in the new specification are slightly to substantially modified, or completely new and different, with respect to the paragraphs in the original specification, and the claims in the present application correspond to the "new"/"modified" specification rather than the original disclosure. In particular, the original disclosure fails to clearly define a "programmable processor" in the manner set forth in the present application and claims (i.e., it is not apparent from the original specification, claims and drawings of the '154 application which disclosed element or elements (see Fig. 2) constitute this "programmable processor" and carry out all the functions thereof, as set forth in the present specification and claims). Further, certain portions of the present specification have no correspondence in the original disclosure--e.g., the last 7 lines of paragraph 0021; line 2 of paragraph 0023; lines 1-2 of paragraph 0024; the last 11 lines of paragraph 0029; lines 2-3 of paragraph 0031; and lines 2-4 of paragraph 0033. In other words, at least the above-identified aspects of the present disclosure are regarded as "new matter" with respect to the original application as filed. Therefore, it appears that the 120 status of the present application should be changed from "continuation" to "continuation-in-part". See also MPEP 201.08 and 37 CFR 1.53(b), part 2.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

i) See paragraph 2 above; as discussed therein, since the present 120 status of this application is as a "continuation" of application 09/841,154, at least the above-identified aspects of the present disclosure are regarded as "new matter" with respect to the original application as filed.

ii) In addition, claim 17 is drawn to a "portable medical monitoring device", which appears to be merely the device 54 shown in Fig. 2; i.e., it is not apparent from the original disclosure that the entire base station 56, including the cradle 64, is combinable with the device 54 as a composite "portable" device (claim 17 recites various elements and functions which do not appear to be part of the device 54, but rather are part of the base station 56 or some other element).

5. Claim 3 is objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 1, a space should appear between "claim" and "1".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, it is unclear if the "medical monitoring service" is hosted by the "programmable processor" (as recited on lines 5-6) or is hosted by the "central node" (as recited on line 9).

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-10 and 12-21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/22330, cited by applicant.

As to claim 17, WO '330 discloses (Fig. 2) a "portable medical monitoring device", note individual information device 12 (which may be an "integrated circuit (Smart) card"--page 7, lines 17-18); remote terminal 30 (which may be a "portable computer" or "personal information device"--page 7, last 2 lines); and provider terminal 32 (which may be a "portable device" such as a "personal digital assistant"). The devices 12, 30 and 32, alone or collectively, provide a "portable" device comprising a "transceiver" for communicating with a "central unit" 14 (note e.g. the two-way communications link between elements 32 and 14 in Fig. 2, and see page 8, lines 13-14); and, a "user interface" and a "programmable processor" (each inherent in a "portable computer", "personal information device", "personal digital assistant", etc), wherein the processor:

(i) receives "user input" specifying "user-specific information" from the information device 12 (see page 7, lines 34-36),

(ii) transmits the user input to central unit 14 for "third-party authorization" based at least in part on the user-specific information (note that the general system shown in Fig. 3 includes "medical insurers/benefit providers" 52, communicating over one or more links with "individual service recipients" 56 and "medical service providers" 58; see Figs. 4, 6 and 7 regarding the processes performed by the insurers 52, service recipients 56 and service providers 58, respectively, which enable the recipient 56 and/or service provider 58 to request "automated authorization of benefits"--see page 4, lines 10-13, page 6, lines 32-35 and page 20, lines 1-19), and

(iii) selectively provides the user with access to a "monitoring service" hosted at the central unit 14 (see e.g. page 4, lines 20-21 and page 9, lines 1-7).

Regarding claim 18, where the "received user input" may be data read from a "Smart card" 12 as discussed above, it is inherent that the identifying data read from the smart card undergoes a "format check" to determine whether the bearer of the card (or the user input thereof) meets one or more "criteria", e.g. whether the identified card bearer is a registered participant (or "health plan" member) of the overall system; note that access to the system is generally described as "secure access" (Abstract).

Regarding claims 19-21, it is inherent that the processor will "refrain from transmitting the received user input" to central unit 14, and/or "deny access (of the user) to the monitoring service", if the user input fails to meet the criteria, and will "provide access to the monitoring service" otherwise, e.g. by the device receiving or not receiving an "activation signal" (see e.g. page 20, lines 15-19 and 34-37).

Claim 10 recites a medical monitoring system comprising a plurality of the "monitoring devices" discussed above; as generally depicted in block 56 of Fig. 3 (see page 24, lines 3-6), the system taught by WO '330 facilitates communications with plural users having corresponding "remote monitoring devices". Further, the "medical monitoring service" discussed above inherently involves "one or more software processes" (i.e., it is an "on-line" service). Still further, the process whereby a user has a smart card 12 read at a terminal 30,32,34,etc (see page 7, lines 34-36 and page 8, lines 33-35) implicitly defines a situation in which the user "seeks access" to the service, and (if authorization is granted) results in an "activation signal" to provide the service.

Regarding claims 12-13, the "programmable processor" (associated with devices 12, 30 and 32) and the central "node" 14 each have access to a variety of "databases" (see again, Figs. 4, 6 and 7), one of which is a "plan/benefit" database 102 having "third-party authorization data" (note again the "authorization" block 108 in Fig. 4), which data is "updat(able)" (page 18, lines 28-29).

Regarding claim 14, see the discussion of claim 18 above.

Regarding claim 15, it is inherent that the "authorization" database 102 may be updated "based on a predetermined event".

Regarding claim 16, see the discussion of claims 19-21 above.

Regarding claim 1, see the discussion of claim 10 above (i.e., the portion of claim 1 after the preamble is essentially identical to the last 7 lines of claim 10).

Regarding claim 3, the authorization determination in WO '330 is inherently "performed cooperatively" between the remote monitoring device (12,30,32) and the central unit 14, in that two-way communication of data between these entities is required in order to provide the authorization, as generally discussed above.

Regarding claim 4, see the discussion of claims 14 and 18 above.

Regarding claim 5, see the discussion of claim 12 above.

Regarding claim 6, see the discussion of claim 13 above.

Regarding claim 7, see the discussion of claim 15 above.

Regarding claim 8, see the discussion of claims 16 and 19-21 above.

Regarding claim 9, the "two-way communications links" discussed above (see e.g. Figs. 1-2) inherently include "either or both of a wired...and a wireless communication link".

10. Claims 2 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining art cited by applicant (most of which was cited in the parent application) is made of record herein (the foreign search report submitted 1/23/04 is noted). Note that redundant citations are crossed out.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 571-272-2965. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

TJM


Thomas J. Mullen, Jr.
Primary Examiner
Art Unit 2632